

## REMARKS

The Examiner rejected claims 88 and 94 under 35 U.S.C. § 112, second paragraph.

The Examiner rejected claims 1, 14, 18, 41, 43, 46, 59, 61, 62, 83, 85 and 86 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shiobara *et al.* Patent No. 5,225,484.

The Examiner rejected claims 58, 60, 82, 84, 87, 90-93 and 96-98 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shiobara *et al.* as applied to the claims hereinabove, and further in view of Christie *et al.* Patent No. 5,668,059 and Papathomas *et al.* Patent No. 6,790,473.

The Examiner rejected claims 89 and 95 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shiobara *et al.* as applied to the claims hereinabove, and further in view of the Materials Research Society Symposium article by Shi *et al.*

Applicant respectfully contends, however, that Papathomas (USP 6,790,473) cannot be used as prior art in rejecting claims of the present patent application under 35 U.S.C. § 103(a), as will be explained *infra*.

In consideration of the fact that Papathomas cannot be used as prior art in rejecting claims of the present patent application under 35 U.S.C. § 103(a), Applicant respectfully traverses the § 103 rejections with the following arguments.

In addition, Applicant respectfully traverses the § 112 rejections with the following arguments.

**35 U.S.C. § 112, Second Paragraph**

The Examiner rejected claims 88 and 94 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Examiner argues: “Claims 88 and 94 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.... There is no antecedent basis for the first flexibilizer of claims 88 and 94 in independent claims 1 and 41 wherefrom they depend. Claims 1 and 41 merely define a flexibilizer as opposed to the "first flexibilizer" of claims 88 and 94.”

In response, Applicant has canceled claims 88 and 94, and has amended claims 1 and 41 to include the limitations of claims 88 and 94, respectively ,such that “first flexibilizer” has been changed to “flexibilizer”.

Accordingly, Applicant respectfully requests that the rejection of claims 88 and 94 under 35 U.S.C. § 112, second paragraph be withdrawn.

### **Papathomas Cannot be Used as a Prior Art Reference**

Applicants respectfully contends that Papathomas (USP 6,790,473) cannot be used as prior art in rejecting claims of the present patent application, because “[e]ffective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention ‘were, at the time the invention was made, owned by the same person or subject to assignment by the same person.’” MPEP 706.02(1)(1). First, the present patent was filed on February 7, 2001 which is after November 29, 1999. Second, the Papathomas patent is being considered by the Examiner as prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e), because the Papathomas patent was published on September 14, 2004 which is after the filing date of February 7, 2001 of the present patent application. Third, both the subject matter of Papathomas patent and the claimed invention of the present patent application were, at the time the invention was made, owned by International Business Machines Corporation or subject to assignment by International Business Machines Corporation. Accordingly, Applicant respectfully maintains that Papathomas cannot be used as a prior art reference under 35 U.S.C. 103(a) against claims of the present patent application.

**35 U.S.C. § 103(a): Claims 1, 14, 18, 41, 43, 46, 59, 61, 62, 83, 85 and 86**

The Examiner rejected claims 1, 14, 18, 41, 43, 46, 59, 61, 62, 83, 85 and 86 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shiobara *et al.* Patent No. 5,225,484.

The Examiner rejected claims 58, 60, 82, 84, 87, 90-93 and 96-98 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shiobara *et al.* as applied to the claims hereinabove, and further in view of Christie *et al.* Patent No. 5,668,059 and Papathomas *et al.* Patent No. 6,790,473.

The Examiner rejected claims 89 and 95 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Shiobara *et al.* as applied to the claims hereinabove, and further in view of the Materials Research Society Symposium article by Shi *et al.*

Applicant has canceled claims 88 and 94, and has amended claims 1 and 41 to include the limitations of claims 88 and 94, respectively. As amended herein, claims 1 and 41 recited the limitations: “wherein the thermoplastic comprises a poly(arylene) ether, and wherein the flexibilizer comprises BIS(2,3-epoxy-2-methylpropyl)ether”.

On page 6 of the Office Action mailed 11/07/2005, the Examiner relied on Papathomas (USP 6,790,473) as allegedly disclosing the preceding features of claims 1 and 41. In particular on page 6 of the Office Action mailed 11/07/2005, the Examiner argues: “Papathomas *et al.* ‘473 (Figure 3 and col. 6, lines 29-37) sets forth ... a blend of a thermoplastic such as the elected species of a **poly(arylene ether)** (col. 18, lines 25-26) dissolved in an epoxy resin monomer (col. 1.9, lines 53-60) such as the elected species of **bis(2,3-epoxy-2-methylpropyl)ether** (col. 19, lines 27-28)”.

As explained *supra*, however, Papathomas cannot be used as prior art in rejecting claims of the present patent application under 35 U.S.C. § 103(a). Accordingly, claims 1 and 41 are not unpatentable under 35 U.S.C. § 103(a) over any reference or combination of references cited in the present office action, because none of said cited references, other than Papathomas, teaches or suggests the preceding features of claims 1 and 41. Therefore, Applicant respectfully contends that claims 1 and 41 are not unpatentable under 35 U.S.C. § 103(a) over Shiobara or any other reference or combination of references cited in the present office action, and that claims 1 and 41 are in condition for allowance.

Since claims 14, 18, 59, and 61-62 depend from claim 1, Applicant respectfully contends that claims 14, 18, 59, and 61-62 are likewise in condition for allowance.

Since claims 43, 44, 46, 83, and 85-86 depend from claim 41, Applicant respectfully contends that claims 43, 44, 46, 83, and 85-86 are likewise in condition for allowance.

Since claims 58, 60, 87, and 90-92, depend from claim 1, Applicant respectfully contends that claims are likewise in condition for allowance.

Since claims 82, 84, 93, and 96-98 depend from claim 41, Applicant respectfully contends that claims are likewise in condition for allowance.

Since claim 89 depends from claim 1, Applicant respectfully contends that claim 89 is likewise in condition for allowance.

Since claim 95 depends from claim 41, Applicant respectfully contends that claim 95 is likewise in condition for allowance.

### CONCLUSION

Based on the preceding arguments, Applicant respectfully believes that all pending claims and the entire application meet the acceptance criteria for allowance and therefore request favorable action. If the Examiner believes that anything further would be helpful to place the application in better condition for allowance, Applicant invites the Examiner to contact Applicant's representative at the telephone number listed below. The Director is hereby authorized to charge and/or credit Deposit Account No. 09-0457.

Date: 10/31/2006

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